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APR 29 2005

OFFICE OF PETITIONS

In re Application of :
Raitano et al. : DECISION ON
Application No. 09/942,052 : PETITION
Filed: August 28, 2001 :
Atty Docket No. 511582002800 :
:

This is a decision on the paper titled "PETITION UNDER RULE 1.47(a)," filed March 17, 2005, which is being treated as a § 1.183 waiver of § 1.131's requirement that all of the inventors sign the declaration of prior inventorship.

The petition under 37 CFR 1.183 is **GRANTED**.

The above-identified application was filed on August 28, 2001. On April 26, 2002, applicants supplied a 37 CFR 1.63 declaration signed by all of the inventors. A final Office action was mailed on September 17, 2004. This office action set a shortened statutory period for reply of three months, with extensions of time obtainable under 37 CFR 1.136(a).

In response, on March 17, 2005, applicants submitted a response, including the instant petition and a declaration under 37 CFR 1.131 (as well as, an RCE and an amendment). This reply was made timely by an accompanying petition and fee for extension of time for response within the third month. The 37 CFR 1.131 declaration was signed by all of the joint inventors, except inventor Faris. Applicants have filed the instant petition to

have the 37 CFR 1.131 declaration entered despite the fact that the declaration was not signed by joint inventor Faris. Petitioner asserts that inventor Faris has refused to execute the declaration.

37 CFR 1.131 states, in pertinent part:

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

In addition, the Manual of Patent Examining Procedure states that "an application or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection."

Here, there has not been a party qualified under 37 CFR 1.42, 1.43, or 1.47. In addition, applicants do not contend that less than all of the named inventors of the application invented the subject matter of the claims under rejection. Accordingly, the proper parties to sign the 37 CFR 1.131 declaration include all of the joint inventors.

In order for a petition under 37 CFR 1.183 to be granted to waive this requirement that joint inventor Faris sign the § 1.131 declaration, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules.

On instant petition, applicants have set forth the steps taken to obtain joint inventor Faris' signature on the § 1.131 declaration. Applicants have shown that a bona fide effort was made to present the § 1.131 declaration and supporting documentation to inventor Faris for signature, to reach inventor Faris by telephone to discuss her failure to execute the declaration, and that by her conduct, inventor Faris has refused to execute the declaration. The declaration presented is signed by joint inventors Raitano, Hubert, Afar, Ge, Challita-Eid and Jakobovits. Under the circumstances, it is concluded that

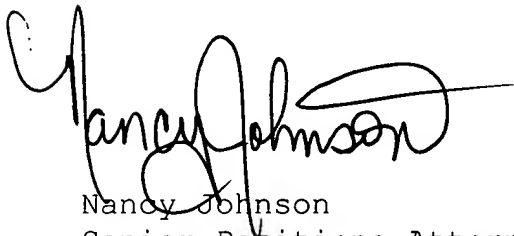
petitioner has demonstrated that this is an extraordinary situation, warranting waiver of the rules.

The petition is granted to the extent that the 37 CFR 1.131 declaration may be entered, despite the fact that its requirement that all of the inventors sign the declaration has not been satisfied. This is not a decision on the merits of the declaration.

The petition fee under 37 CFR 1.17(f) of \$400 required for consideration of this petition under § 1.183 has been charged to Deposit Account No. 03-1952, as authorized.

The application file is being forwarded to Technology Center 1642 for consideration on the merits of the reply and the 37 CFR 1.131 declaration, filed March 17, 2005.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a stylized flourish extending from the end of the name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions